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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NUMBER: 10/824,744

EXAMINER: JULES, FRANTZ F.

FILING DATE: 04/15/2004

ART UNIT: 3617

FIRST NAMED INVENTOR: COWAN

ATTORNEY DOCKET NO.: 2044

TITLE: LINEAR MOTORS POWERED DIRECTLY BY PULSATING CURRENT

APPLICATION HAS SPECIAL STATUS (AGE)

TRAVERSAL OF ALL OBJECTIONS AND REJECTIONS  
CONTAINED IN FIRST OFFICE ACTION

Applicant hereby respectfully traverses and requests withdrawal of each of the claim objections and rejections stated in the first Office Action mailed 09/09/2004, and requests early allowance of all of the claims as filed, on the grounds detailed below.

Claim Objections

Claim 1 was objected to because of the article "a" in line 16, with a requirement stated for deletion of same<sup>1</sup>, and the claims dependent from claim 1, claims 2-25 and 27-34 were objected to as being dependent from objected base claim 1<sup>2</sup>. No reason was stated for the objection to the article "a" in claim 1.

The article "a" objection/requirement should be withdrawn because it does not meet a basic requirement for completeness of an objection/requirement<sup>3</sup>, in that it fails to state any reason for the objection/requirement as mandated by §132(a) of the patent

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<sup>1</sup> Office Action §1.

<sup>2</sup> id.

<sup>3</sup> 37 C.F.R. §104(a)(1), (b).

statutes<sup>4</sup>.

Although claims 2, 6, 8-23 and 30-34 were objected to as being dependent from a rejected base claim, claim 1, though the examiner stated that these dependent claims each contained allowable subject matter if rewritten in independent form<sup>5</sup>, it is shown below that the obviousness rejection of claim 1 should be withdrawn in that the examiner has not made out a prima facie case for obviousness of claim 1; accordingly the objection to claims 2, 6, 8-23 and 30-34 should be withdrawn.

#### Claim Rejections for Alleged Obviousness

There was no rejection of any claim for anticipation or indefiniteness, but claims 1, 4-5, 7, 26-29 were rejected for alleged obviousness in light of Maki and Nelson<sup>6</sup>; and claims 3 and 24-25 were rejected for alleged obviousness in light of Maki, Nelson and Heidelberg<sup>7</sup>. It is shown below that all of these obviousness rejections are untenable because the examiner has not made out a prima facie case of obviousness for either of the only two independent claims, claims 1 and 26, and that accordingly all of the rejected claims must be deemed nonobvious. As a predicate for that showing, it is useful to summarize applicable law.

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<sup>4</sup> 35 U.S.C. §132(a) provides in pertinent part: "Whenever on examination ... any objection or requirement [is] made, the Director shall notify the applicant thereof, stating the reasons for such ...objection or requirement..." (emphasis added).

<sup>5</sup> Office Action §5.

<sup>6</sup> Office Action §3.

<sup>7</sup> Office Action §4.

Law Applicable to Validity of Claim Rejections  
Based on Prior Art

Burden of Proof is on Examiner

Of course the examiner bears the initial burden of establishing a prima facie case that any claims are allegedly obvious in light of the prior art, as the Patent and Trademark Office has recognized<sup>8</sup>. The rejection is improper and shall be overturned if the examiner has not met that burden<sup>9</sup>. And where the examiner has not made out a prima facie case of obviousness, the applicant has no obligation to submit evidence of nonobviousness<sup>10</sup>.

A Prima Facie Showing of Obviousness  
Must Cover Every Claim Limitation

The Patent and Trademark Office has made clear for the examining corps that it is not sufficient, to make out a prima facie case of obviousness of a claim to the present invention, to show that the claimed invention as a whole is obvious, or that most of the claim limitations are obvious. A prima facie showing must

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<sup>8</sup> MPEP §2142 at 2100 - 128 (Ed. 8, Rev. 2, May 2004) ("The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) ("In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. [citation omitted]"); In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

<sup>9</sup> Rijckaert, supra, 9 F.3d at 1532, 28 USPQ2d at 1956 ("If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. [citation omitted]").

<sup>10</sup> MPEP §2142 at 2100-128 (Ed. 8, Rev. 2, May 2004) ("If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.").

cover each and every claim limitation<sup>11</sup>.

A Claim Dependent from a Nonobvious Claim  
Is Also Nonobvious

For purposes of both possible anticipation of a patent claim by a cited prior art reference and also possible obviousness in light of prior art, the Federal Circuit court has repeatedly made clear that any patent claim dependent from a patentable claim is also patentable, since said dependent claim not only incorporates the limitations of the original claim<sup>12</sup> but also contains additional limitations<sup>13</sup>. The Patent and Trademark Office has expressly agreed in the MPEP<sup>14</sup>.

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<sup>11</sup> MPEP §2143.03 at 2100-133 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") (emphasis added) (Ed. 8, Rev. 2, May 2004).

<sup>12</sup> 35 U.S.C. § 112 ¶ 4.

<sup>13</sup> Hartness Intern. Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987) ("For the reasons stated below, the district court was correct in holding that independent claim 1 was nonobvious. A fortiori, dependent claim 3 was nonobvious (and novel) because it contained all of the limitations of claim 1 plus a further limitation."); In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (holding that "...dependent claims are nonobvious if the independent claims from which they depend are nonobvious...", in reversing the PTO Board's obviousness rejection of dependent claims, on the basis of the court's reversal of the Board's obviousness rejections of the corresponding independent claims); In re Fine, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.").

<sup>14</sup> MPEP §2143.03 at 2100-133 (Ed. 8, Rev. 2, May 2004) ("If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious.")

The Examiner Must Interpret a Means/Function Clause  
Per the Specific Means Disclosed in the Specification  
And Equivalents of Those Specific Means

A means/function clause is interpreted to cover the specific means disclosed in the specification for performing the indicated function, plus any equivalents thereof<sup>15</sup>. It is clear from two 1994 Federal Circuit en banc decisions, the Donaldson and Alappat opinions noted just below, that the examiner must carefully consider the specific means disclosed in applicant's specification, and equivalents thereof, in interpreting a means/function clause, for purposes of both alleged claim anticipation and alleged obviousness; the examiner may not simply interpret the means/function clause by itself, as broadly as its own language would allow, as occurred in some prior Office practice<sup>16</sup>. This

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<sup>15</sup> 35 U.S.C. §112 ¶6.

<sup>16</sup> In its major 1994 en banc Donaldson decision, the Federal Circuit held that the PTO is required to interpret a means/function clause in light of the specification, rather than simply relying on the language of the clause itself, in spite of the Office's argument that claims should be given the broadest reasonable interpretation during patent prosecution. In re Donaldson Co., Inc., 16 F.3d 1189, 1193 - 1195, 29 USPQ2d 1845, 1848 - 1850 (Fed. Cir. 1994) ("The plain and unambiguous meaning of paragraph six [of 35 USC §112] is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be....[W]e hold that paragraph six applies regardless of the context in which interpretation of means-plus-function language arises, i.e. whether as part of a patentability determination in the PTO or as part of a validity or infringement determination in a court....Contrary to the suggestion by the Commissioner, our holding does not conflict with the principle that claims are to be given their broadest reasonable interpretation during prosecution. [citation omitted]. Generally speaking, this

claim interpretation principle remains intact. Rather, our holding in this case merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.' Per our holding, the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." (emphasis added)).

Of course case law concerning claim interpretation for purposes of deciding literal infringement by later structures may be applied for purposes of deciding the issue of alleged claim anticipation by prior art, under the well established principle, "that which will [literally] infringe if later will anticipate if earlier." Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 108 S.Ct. 702 (1988)("That which would literally infringe if later in time anticipates if earlier than the date of invention." (emphasis in original)).

In the interpretation of a means/function clause under 35 U.S.C. §112 ¶ 6, for purposes of deciding literal infringement, and therefore for purposes of deciding anticipation also under Lewmar Marine, supra, the decision as to whether the means/function clause reads upon a later or prior art device requires careful comparison not only of the functions of the claimed means and the other structure, but also of the structures disclosed in the specification corresponding to the means/function clause, and the other structure. Pennwalt v. Durand-Wayland, Inc., 833 F.2d 931, 934, 4 USPQ2d 1737, 1739 (Fed. Cir. 1987)(in banc), cert. denied, 108 S.Ct. 1226, 1474 (1988)("To determine whether a claim limitation is met literally, where expressed as a means for performing a stated function, the court must compare the accused structure with the disclosed structure, and must find equivalent structure as well as identity of claimed function for that structure." (emphasis in original)); Intellectall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388 - 1389, 21 USPQ2d 1383, 1387 (Fed. Cir. 1992)("Under 35 U.S.C. §112, ¶ 6, to satisfy a means-plus-function limitation literally, the accused device must perform the identical function required by the limitation and must incorporate the structure disclosed in the specification, or its substantial structural equivalent, as the means for performing that function.")

In Pennwalt, supra, the Federal Circuit held that in such analysis, 35 USC §112 ¶6 does not allow a means/function clause to be interpreted as reading on every means for performing the stated function:

"Thus, section 112, paragraph 6, rules out the possibility that any and every means which performs the function stated in the claim literally satisfies that limitation. While

holding of Donaldson was made even more explicit by the en banc decision in Alappat<sup>17</sup>

The Office has expressly accepted the Donaldson/Alappat holding that a means/function clause must be so interpreted by the examiner during patent prosecution, expressly recognizing that this is contrary to earlier practice in the Office, and also providing some guidance for examiners in implementing the new practice<sup>18</sup>.

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encompassing equivalents of those disclosed in the specification, the provision, nevertheless, acts as a restriction on the literal satisfaction of a claim interpretation."

833 F.2d at 934, 4 USPQ2d at 1739.

<sup>17</sup> In re Alappat, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (Following Donaldson in reversing the PTO Board's decision affirming the examiner's claim rejections, and stating: "Given Alappat's disclosure, it was error for the Board majority to interpret each of the means clauses in claim 15 so broadly as to 'read on any and every means for performing the functions' recited, as it said it was doing...").

<sup>18</sup> MPEP §2181 at 2100 - 220 (Ed. 8, Rev. 2, May 2004), stating that in Donaldson the Federal Circuit had "decided that a 'means-or-step-plus-function' limitation should be interpreted in a manner different than patent examining practice had previously dictated.", so that now, per Donaldson and 35 U.S.C. §112 ¶6, a means/function clause "...must be interpreted to cover [only] the corresponding structure, materials or acts in the specification and equivalents thereof." MPEP §2181 at 2100-223 (Ed. 8, Rev. 2, May 2004). And in deciding the equivalence issue, upon reviewing applicant's response to an examiner's claim rejection, it is appropriate to consider applicant's comparative citation of relevant material from the specifications of the present application and the prior patent, MPEP § 2184 at 2100 - 230 (Ed. 8, Rev. 2, May 2004), and to consider whether the prior art element performs the function specified in the claim in substantially the same way to produce substantially the same result as the corresponding element disclosed in the specification of the present patent application. MPEP § 2184 at 2100 - 231 (Ed. 8, Rev. 2, May 2004).

Valid Obviousness Rejection from Combining References  
Requires Record Evidence Suggesting the Combination

Several recent Federal Circuit decisions have further strengthened the court's oft-stated requirement, that a valid obviousness rejection based on combining elements of different prior art references, requires a showing of "evidence of a suggestion, teaching or motivation" to combine the prior art references<sup>19</sup>, by making clear that:

1. The required showing more often comes from the prior art references themselves, though it may come from the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved<sup>20</sup>, though prior art recognition of an unsolved problem does not render obvious the present inventor's solution to that problem<sup>21</sup>;

2. The required showing must be based on actual evidence of record, revealed by thorough and searching inquiry, rather than

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<sup>19</sup> In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 1348, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000), cert denied, 120 S.Ct. 2679 (2000).

<sup>20</sup> id.

<sup>21</sup> Cardiac Pacemakers, Inc. et al v. St. Jude Medical, Inc. et al, \_\_\_ F.3d \_\_\_ (Fed. Cir. Aug. 31, 2004) at p. 8 of opinion published at Georgetown University Law School website, [www.ll.georgetown.edu](http://www.ll.georgetown.edu) ("Recognition of the problem of treating complex heart arrhythmias does not render obvious the eventual solution. Recognition of a need does not render obvious the achievement that meets that need.....Recognition of an unsolved problem does not render the solution obvious."; JMOL of obviousness reversed).



being based on mere argument of the examiner<sup>22</sup>;

3. The required showing must be both "clear and particular" and supported by specific factual findings<sup>23</sup>; and

4. The requirement for such an evidentiary showing must be rigorously applied in order to prevent improper hindsight application of the present inventor's own teachings against him<sup>24</sup>.

These points, from the most current Federal Circuit case law, further strengthen the court's earlier case law requiring a showing of some teaching or suggestion supporting the idea of making the

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<sup>22</sup> In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching. [citation omitted]. It must be based on objective evidence of record.")(emphasis added)(obviousness rejections reversed); Dembiczak, 175 F.3d at 999 (Stating that although the required showing might come from the multiple sources indicated, this "does not diminish the requirement for actual evidence.", and that "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence' [to make the required showing]."; also citing earlier Federal Circuit authority that the teaching or suggestion or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding.")

<sup>23</sup> In re Sang-Su Lee, supra, 277 F.3d at 1343 ("The need for specificity pervades this authority [citation omitted] [and] particular findings must be made as to the reasons the skilled artisan with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.")(obviousness rejections reversed); Dembiczak, 175 F.3d at 999; Winner Int'l Royalty Corp., 202 F.3d at 1348-1349;

<sup>24</sup> Dembiczak, 175 F.3d at 999 ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")(emphasis added), cited with approval in re Sang-Su Lee, supra, 277 F.3d at 1343.

combination<sup>25</sup>, recognized by The Patent and Trademark Office, as reflected by both the Manual of Patent Examining Procedure<sup>26</sup> and decisions of the Board of Patent Appeals and Interferences<sup>27</sup>.

The earlier Federal Circuit case law also taught that the teaching or suggestion to combine elements of prior art references

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<sup>25</sup> In re Bell, 991 F.2d 781, 784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. [Prior citations omitted]"; reversing PTO obviousness rejection relying on combining references); In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990)(stating substantially same test; PTO obviousness rejection reversed); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988) ("Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art. [citation omitted]. But it cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.[citation omitted]" (emphasis added); PTO obviousness rejection reversed).

<sup>26</sup> MPEP §2143.01 at 2100 - 130 (Ed. 8, Rev. 2, May 2004)("Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.")

<sup>27</sup> Ex parte Levengood, 28 USPQ2d 1300, 1301 (Bd.Pat.App.&Int. 1993)("In order to establish a prima facie case of obviousness, it is necessary for the examiner to present evidence, [citation omitted] preferably in the form of some teaching, suggestion or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. [citation omitted]." (emphasis in original); reversing examiner's obviousness rejection based on combining prior art references.); Ex parte Kranz, 19 USPQ2d 1216, 1218 (Bd.Pat.App.&Int. 1991)("Before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. [citation omitted]."; reversing examiner's obviousness rejection.)

must not come merely from argument alleging obviousness; but must be found in evidence in the record<sup>28</sup>. This requirement, that the suggestion of the present invention be found in the evidentiary record, as opposed to examiner argument, is fully applicable to obviousness determinations in the PTO, per the Federal Circuit Court of Appeals<sup>29</sup>.

And earlier Federal Circuit case law also recognized that in order for the prior art to render the present invention obvious, the teaching or suggestion of making the combination found in the

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<sup>28</sup> C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340 (Fed. Cir. 1998), cert. denied, 526 U.S.1130(1999)(In the course of reversing a jury determination that certain patent claims were obvious, pp. 1361-2, the court stated, at p. 1361: "The ultimate question is whether, from the evidence of the prior art and the knowledge generally available to one of ordinary skill in the relevant art, there was in the prior art an appropriate teaching, suggestion, or motivation to combine components in the way that was done by the inventor.")(emphasis added); Micro Chemical, Inc. v. Great Plains Chemical Co., Inc., 103 F.3d 1538, 1546, 41 USPQ2d 1238 (Fed. Cir. 1997), cert. denied, 117 S. Ct. 2516 (1997)(In holding that the patent in suit was not invalid for obviousness, the court observed, "Here the record contains no evidence of a motivation or suggestion to combine the [prior art] machines." (emphasis added)).

<sup>29</sup> In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992)(In reversing the PTO's determination that applicant's invention was obvious, the court stated: "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the [present invention] combination." (emphasis added)). Though Judge Nies' concurring opinion can be construed as disagreeing with, or at least attempting to soften, the "in the prior art" requirement as to source of the suggestion, the above-quoted language of the panel opinion is of course controlling, rather than the opinion of a single panel member, even if Judge Nies' opinion is deemed contra to the panel on this point.

present invention, must be a plain or clear one<sup>30</sup>.

In evaluating the prior art of record for a suggestion of the present invention, one may not employ hindsight knowledge from the present invention to decide what the prior art does suggest; i.e. one may not use the present inventor's own disclosure against him, on the obviousness issue<sup>31</sup>. The Patent and Trademark Office

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<sup>30</sup> Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 32 (Fed. Cir. 1985) ("Where, as here, nothing of record plainly indicates that it would have been obvious to combine previously separate process steps into one process, it is legal error to conclude that a claim to that process is invalid under § 103." [emphasis added]); King Instrument Corp. v. Otari Corp., 767 F.2d 853, 859, 226 USPQ 402, 405 (Fed. Cir. 1985), cert. denied, 475 U.S. 1016 (1986) (In affirming a district court holding of patent validity, the Federal Circuit coupled its citation of Fromson, supra as authority for the suggestion test, with the parenthetical reference, "(nothing of record plainly indicated it would have been obvious to combine the prior art)"; [emphasis added]); Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1449, 223 USPQ 603, 610 (Fed. Cir. 1984) (In reversing the district court's determination that a claim for a sanitary napkin was obvious, the Federal Circuit court stated: "Since the trial court's opinion lacks a comparison of [the invention]... with the prior art, we have made it ourselves, examining all the references of record, and we fail to find a clear suggestion of the claimed subject matter." [emphasis added])).

<sup>31</sup> Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551 (Fed. Cir. 1996) (In holding that the patented device was nonobvious, the court observed, immediately after stating that the prior art references did not suggest the invention in suit, "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the [present] invention as a template for its own reconstruction-an illogical and inappropriate process by which to determine patentability. [citation omitted] The [present] invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. [citation omitted]"); In re Fine, supra, at 837 F.2d 1075, 5 USPQ2d 1599 - 1600 (After noting that the prior art contained no suggestion of the combination involved in Fine's invention, the court observed, "Instead, the Examiner relies on hindsight in reaching his obviousness determination. But this court has said, 'To imbue one of ordinary skill in the art with knowledge of the invention in

expressly mandates that examiners are not to make hindsight use of the present invention disclosure in construing the prior art<sup>32</sup>, consistent with Federal Circuit case law to the same effect<sup>33</sup>.

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suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. [citation omitted]. It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made...to occupy the mind of one skilled in the art who is presented only with the [prior art] references, and who is normally guided by the then-accepted wisdom in the art.' [citation omitted]. One cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention."(emphasis added)); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994)(Noting the "well-settled principles" in obviousness determination, that "...multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the [present invention] disclosure. [citation omitted].")

<sup>32</sup> MPEP § 2142 at 2100 - 128 (Ed. 8, Rev. 2, May 2004)("To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences', conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based on the applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (emphasis added))

<sup>33</sup> See, e.g., In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992)(Stating that suggestion of the combination of elements found in the present invention "can not come from the applicant's invention itself"; PTO obviousness determination reversed).

Application of Law to Present Rejections

The Examiner Has Not Made Out a Prima Facie Case  
of Obviousness for Either Independent Claim

It is readily seen that the examiner has not made out a prima facie case of obviousness of either independent claim, claim 1 and claim 26:

Among the limitations of claim 1 is the following<sup>34</sup>:

"A spacing arrangement means, for spacing of said motor parts, to achieve the function of minimizing the number of road parts required per mile of said road;"

And among the limitations of claim 26 is the following<sup>35</sup>:

"A spacing and timing control means, for spacing of said motor parts and for controlling timing of said switching of said current to said motor, to perform the functions of allowing continuous transmission of power to said motor for both propulsion and braking of said vehicle, and minimizing the number of road parts required to be present along said road."

Yet the Office Action section stating the basis for the rejections of claims 1 and 26<sup>36</sup> cites no portions of the disclosures of the cited patents as allegedly disclosing any means equivalent to applicant's means, for either of these means/function clauses, and indeed makes no reference at all to the functions of minimizing the required numbers of road parts, or allowing continuous transmission of power to the motor.

Equally important, the Office Action cites no record evidence at all that would allegedly suggest combining the references cited,

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<sup>34</sup> Claim 1, lines 12 - 14.

<sup>35</sup> Claim 26, lines 12 - 17.

<sup>36</sup> Office Action §3.

Maki and Nelson, as required by the authority cited above to allow establishment of a prima facie case by combining these references, even if such a combination would otherwise support the rejection, as to which the examiner has made no showing at all.

Since no prima facie case of obviousness has been made out for either of the independent claims, claims 1 and 26, each must be deemed nonobvious, under the above-cited authority.

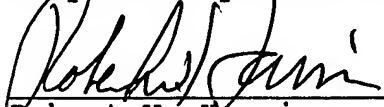
All the Dependent Claims Are Nonobvious

Since all of the other claims, claims 2-25 and 27-34, are dependent claims, and since it is well established under the authority cited above, that any claim dependent from a nonobvious independent claim is also nonobvious, it follows that all of the dependent claims are nonobvious.

Conclusion

For all of the reasons given above, each of the claim objections and rejections is erroneous and should be withdrawn. Applicant respectfully requests early allowance of all of the claims as filed.

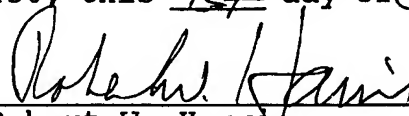
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CERTIFICATE OF MAILING)

This will certify that the original of the foregoing document was deposited with the U.S. Postal Service, with sufficient postage as first class mail, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, this 1<sup>st</sup> day of October, 2004.

  
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